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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,697	07/14/2003	Mary Wonmon Chin	29250-001055/US	3734

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EXAMINER	
CUMMING, WILLIAM D	
ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/617,697	CHIN ET AL.	
	Examiner	Art Unit	
	WILLIAM D. CUMMING	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) *1-16,27-32 and 34* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-26 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims 1-16, 27-32 and 34 drawn to an invention nonelected with traverse in the response filed August 19, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17-26 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Maupin, et al** (both patents)

Maupin, et al disclose a method of performing an emergency call back ("*When establishing an emergency call connection towards a Public Safety Answering Point (PSAP) terminal for a mobile subscriber, instead of transmitting the Mobile Station Integrated Service Directory Number (MSISDN) assigned to the mobile station, a directory number assigned to the serving mobile switching center/visitor location register (MSC/VLR) is transmitted as the Calling Party Number. The MSISDN number is stored into the Generic Address Parameter (GAP) within the transmitted Initial Address Message (IAM) signal. When the PSAP attempts to call back the mobile station in response to a disconnection of the original emergency call connection, the PSAP transmits another IAM signal with the received MSC directory number as the Called Party Number. Once the setup signal is routed to the serving MSC/VLR, an application module within the serving MSC/VLR extracts the MSISDN from the GAP to call back the proper mobile station.")* with a mobile station (figure 3, #30), comprising: sending a call back request ("*Even though the above TLDN solution alleviates the delays mandated by the handling of incoming calls within a mobile telecommunications system, there still exists certain undesirable system limitations. Because the TLDN list 150 contains a limited number of directory numbers, the numbers have to be recycled once they are released by a particular emergency call. In order to determine when the assigned TLDN number can be reused, the serving*

MSC/VLR 40 marks the assigned numbers as released after a certain period of time. For example, forty-five minutes after a particular TLDN number has been assigned to the mobile station 30, the assigned TLDN number is released and the data within the register (R) 140 correlating the assigned TLDN with the mobile station 30 are deleted. As a result, if a call back request from the PSAP 110 is received after the assigned TLDN has already been released, the call back request fails. Moreover, if the number of emergency calls ever exceeds the number of available TLDNs in the list 130, subsequently received emergency call setup requests have to be processed without assigning TLDNs. Alternatively, the serving MSC/VLR 40 has to overwrite some of the previously assigned TLDNs with the subsequently received call setup requests using a recycling mechanism such as first-in-first-out (FIFO). ") to a call register, the call back request requesting that a mobile switching center (#40), serving the mobile station (30), establish a call between the mobile station (#30) and a public service answering point (#110).

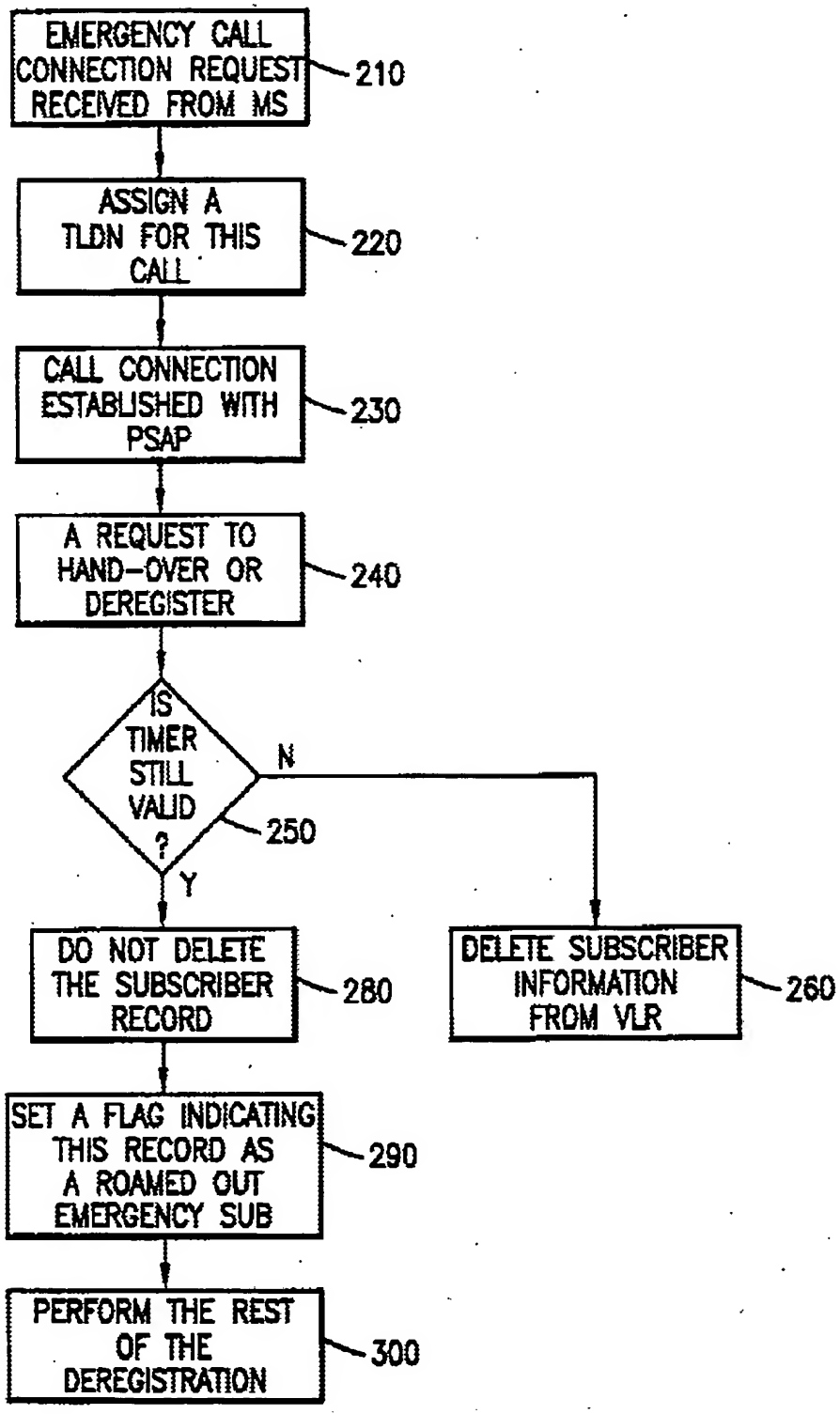
EMERGENCY CALL CONNECTION REQUEST RECEIVED FROM MS
210
ASSIGN A TLDN FOR THIS CALL
220
CALL CONNECTION ESTABLISHED WITH PSAP
230
A REQUEST TO HAND-OVER OR DEREGISTER
240
IS TIMER STILL VALID ?
250
N
Y
DO NOT DELETE THE SUBSCRIBER RECORD
280
DELETE SUBSCRIBER INFORMATION FROM VLR
260
SET A FLAG INDICATING THIS RECORD AS A ROAMED OUT EMERGENCY SUB
290
PERFORM THE REST OF THE DEREGISTRATION
300

FIG. 4

Response to Arguments

5. Applicant's arguments filed January 27, 2006 have been fully considered but they are not persuasive.

Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is *"inherent"* or otherwise implicit in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). In response to Applicant's argument, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference *"teach"* what the subject patent teaches. Assuming that a reference is properly *"prior art,"* it is only necessary that the claims under consideration *"read on"* something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or *"fully met"* by it. It was held in In re Donohue, 226 USPQ 619, that, *"It is well settled that prior art under 35 USC §102(b)must sufficiently describe the claimed invention to have placed the public in possession of it...Such possession is effected if one of ordinary skill in the art could have combine the description of the invention with his own knowledge to make the claimed invention."* Clear inference to the artisan must be considered, In re

Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be *"given the broadest reasonable interpretation consistent with the specification."* Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome "*heavy presumption*" that term takes on its ordinary meaning simply by pointing to preferred embodiment (Teleflex Inc. v. Ficosa North America Corp., CA FC, 6/21/02, 63 USPQ2d 1374). Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969). *"Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102."* Twin Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference *"teaches away"* from the invention is inapplicable to an anticipation analysis. Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

Maupin, et al sending a call back request ("*Even though the above TLDN solution alleviates the delays mandated by the handling of incoming calls within a mobile telecommunications system, there still exists certain undesirable system limitations. Because the TLDN list 150 contains a limited number of directory numbers, the numbers have to be recycled once they are released by a particular emergency call. In order to determine when the assigned TLDN number can be reused, the serving MSC/VLR 40 marks the assigned numbers as released after a certain period of time. For example, forty-five minutes after a particular TLDN number has been assigned to the mobile station 30, the assigned TLDN number is released and the data within the register (R) 140 correlating the assigned TLDN with the mobile station 30 are deleted. As a result, if a call back request from the PSAP 110 is received after the assigned TLDN has already been released, the call back request fails. Moreover, if the number of emergency calls ever exceeds the number of available TLDNs in the list 130, subsequently received emergency call setup requests have to be processed without assigning TLDNs. Alternatively, the serving MSC/VLR 40 has to overwrite some of the previously assigned TLDNs with the subsequently received call setup requests using a recycling mechanism such as first-in-first-out (FIFO). ")* to a call register, the call back request requesting that a mobile switching center (#40), serving the mobile station (30), establish a call between the mobile station (#30) and a public service answering point (#110).

In response to Applicants' argument that the references includes additional structure or functions not required by Applicants' invention, it must be noted that the references disclose the invention as claimed. The fact that it discloses additional structure or functions not claimed is irrelevant.

In response to applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., support roaming) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding the prior art (In re Sporck, 155 USPQ 687). Attempt to invoke limitations present in the preferred embodiment but absent from the claims themselves violates the established claim construction principles.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS from** the mailing date of this final action.

8. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

9. If applicants request an interview after this **final rejection**, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to **restate arguments** of record or to **discuss new limitations** which would require more than nominal reconsideration or new search will be denied.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 571-272-7861. The examiner can normally be reached on Monday-Thursday, 11:00am-8:00pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571-272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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